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150 Broadway, suite 702  
New York, NY 10038

EXAMINER
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MILES, JONATHAN WADE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* OSCAR R. CARRILLO, JR., SAMUEL RAYBIN,  
PAUL SMITH, and TRACY ANDREOTTI

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Appeal 2016-000338  
Application 13/791,211  
Technology Center 3700

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Before LINDA E. HORNER, ANNETTE R. REIMERS, and  
THOMAS F. SMEGAL, *Administrative Patent Judges*.

REIMERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Oscar R. Carrillo, Jr. et al. (Appellants) appeal under 35 U.S.C.  
§ 134(a) from the Examiner's decision to reject claims 1–13 under 35 U.S.C.  
§ 102(b) as anticipated by Watson (US 5,788,715, iss. Aug. 4, 1998).  
Claims 14–20 have been canceled. We have jurisdiction under 35 U.S.C.  
§ 6(b).

We AFFIRM.

### CLAIMED SUBJECT MATTER

The claimed subject matter relates to devices “for use with elongated medical devices, such as endoscopes and the like.” Spec. ¶ 2, Figs. 2–4.

Claims 1 and 8 are independent.

Claim 1 is illustrative of the claimed subject matter and recites:

1. A medical device comprising:  
an elongate member sized and shaped for insertion into a primary lumen of an elongated medical device,  
the elongate member comprising a dividing wall structure, the dividing wall structure sized so that, when inserted into the primary lumen, the dividing wall structure divides the primary lumen of the elongated medical device into a plurality of secondary lumens.

### ANALYSIS

Appellants do not offer arguments in favor of independent claim 8<sup>1</sup> or dependent claims 2–7 and 9–13 separate from those presented for independent claim 1. *See* Appeal Br. 3–5. We select claim 1 as the representative claim, and claims 2–13 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

Independent claim 1 is directed to a medical device including an elongate member having a dividing wall structure that “divides the primary lumen of [an] elongated medical device into a plurality of secondary lumens.” Appeal Br. 7, Claims App. The Examiner finds that the “elongated medical device” is “dispenser 440” of Watson and “the primary lumen [is] the entire inner space as defined by the elongated medical device 440.” Ans. 5; *see also* Final Act. 3. The Examiner further finds that

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<sup>1</sup> *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011).

“elongate member 476” of Watson “has a dividing wall structure as shown in Fig[ure] 15B which separates the primary lumen [of dispenser 440] into the space outside the elongate member 476 and each of the smaller lumens 482a-c and 478B, thus dividing the primary lumen into a plurality of secondary lumens.” Ans. 5–6; *see also* Final Act. 3.

Appellants contend that “the elongate member 476 [of Watson] does not in any way separate the primary lumen of the dispenser 440.” Reply Br. 3; *see also* Appeal Br. 4–5. According to Appellants, “it is not the lumen of the medical device [dispenser 440] that is divided, but only the lumen of the catheter 476. The catheter 476 simply takes up a portion of the primary lumen [of dispenser 440].” Appeal Br. 5.

At the outset, we agree with the Examiner that the elongated medical device “is not positively claim[ed] . . . . Therefore, the device of Watson only merely needs to be capable of being inserted into the primary lumen of an elongated medical device.” Final Act. 6; *see also* Adv. Act. 2 (mailed May 14, 2015); Ans. 6–7. However, claim 1 *positively recites* that the “dividing wall structure” of the elongated member “divides the primary lumen of the elongated medical device into a plurality of secondary lumens.” Appeal Br. 7, Claims App. As such, we disagree with the Examiner that catheter 476 of Watson only needs to be “capable of dividing the primary lumen [of an elongated medical device] into a plurality of second lumens.” Adv. Act. 2. Rather, the dividing wall structure must be sized relative to the size of the primary lumen of the elongated medical device, so that when inserted into this primary lumen, the dividing wall structure divides the primary lumen into a plurality of secondary lumens. *See* Appeal Br. 7, Claims App.

Watson discloses that “[a] dispenser **440** . . . comprises telescoping cylinders **442**, **444**, **446** having ligating bands **50** disposed thereon. In FIG. **13**, the dispenser **440** is shown assembled onto the tubular housing **32** [of ligating instrument **30**]” (Watson 15:59–62, Figs. 13–17; *see also id.* at 6:57–58, Fig. 1) and “FIGS. **15A**, **15B**, and **15C** illustrate cross sections of various channel **76** configurations that may be *provided in the tubular housing 32*, or in a multilumen catheter **476** *inserted therethrough*” (Watson 16:51–54 (emphasis added)). In other words, Watson discloses that dispenser **440** is “assembled onto” tubular housing **32** of ligating instrument **30** and catheter **476** may be inserted through tubular housing **32** of ligating instrument **30**. Watson is silent as to how catheter **476** relates to dispenser **440** let alone that the dividing walls of multi-lumen catheter **476** divide the primary lumen of dispenser **440** into a plurality of secondary lumens. Moreover, the Examiner fails to provide sufficient evidence or technical reasoning to support the finding that catheter **476** of Watson “divides the lumen of the dispenser [**440**] into a plurality of secondary lumens, some of the secondary lumens being within the catheter **476** and at least one secondary lumen being the primary lumen portion outside of the catheter **476**.” *See Adv. Act. 2*. As such, the Examiner fails to establish by a preponderance of the evidence that the dividing walls of multi-lumen catheter **476** of Watson divide the primary lumen of dispenser **440** into a plurality of secondary lumens.

However, in the Answer, the Examiner takes an alternate position. In particular, the Examiner finds that housing **32** of Watson may be “considered the elongated medical device and the lumen defined by the housing **32** is the primary lumen . . . [and] when the elongate member **476** is

inserted therethrough, the primary lumen of the elongated medical device 32 is divided into a plurality of secondary lumens.” Ans. 6.

In response, Appellants contend that “it is the lumen of the elongated member itself that is divided into a plurality of lumens.” Reply Br. 4.

Appellants do not dispute the Examiner’s finding that housing 32 of Watson constitutes “the elongated medical device and the lumen defined by the housing 32 [constitutes] the primary lumen.” *See* Ans. 6; *see also* Reply Br. 4. Moreover, Appellants acknowledge that “multilumen catheter 476 [of Watson] is *completely contained within* the tubular housing 32.” Appeal Br. 4 (emphasis added); *see also* Reply Br. 3. In this case, we agree with the Examiner that “when [the dividing wall structure of the multi-lumen] elongate member 476 [of Watson] is [inserted into the primary lumen of elongated medical device 32], the primary lumen of the elongated medical device 32 is divided into a plurality of secondary lumens.” *See* Ans. 6; *see also* Watson 16:51–54, Figs. 15A–15C.<sup>2</sup> Appellants do not provide persuasive evidence or argument to the contrary.

Accordingly, we sustain the Examiner’s rejection of independent claim 1 as anticipated by Watson. We further sustain the rejection of claims 2–13, which fall with claim 1.

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<sup>2</sup> The Specification describes that “the elongate member 30 is a *multi-lumen* tubular insert.” Spec. ¶ 32 (emphasis added), Figs. 3, 4; *see also* Appeal Br. 3.

DECISION

We AFFIRM the decision of the Examiner to reject claims 1–13 as anticipated by Watson.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED